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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,121	07/24/2001	Tim Goldstein	10007822-1	4459

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Intellectual Property Administration
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EXAMINER	
PEREZ GUTIERREZ, RAFAEL	
ART UNIT	**PAPER NUMBER**
2686	

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/912,121	Goldstein	
	Examiner	Art Unit	
	Rafael Perez-Gutierrez	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24 and 26-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24 and 26-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 July 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/7/03 & 10/28/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 10, 2005 has been entered. **Claims 1-24 and 26-33** are now pending in the present application.

Information Disclosure Statement

2. The information disclosure statements submitted on February 7, 2003 and October 28, 2004 have been considered by the Examiner and made of record in the application file.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference number not mentioned in the description: On **figure 5**, reference number **97** is not mentioned in the description.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to

the Office Action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the Examiner, the Applicant will be notified and informed of any required corrective action in the next Office Action. If a response to the present Office Action fails to include proper drawing corrections, corrected drawings or arguments therefor, the response can be held **NON-RESPONSIVE** and/or the application could be **ABANDONED** since the objections/corrections to the drawings are no longer held in abeyance.

Specification

5. The disclosure is objected to because of the following informality: In **line 9** of the amended paragraph submitted on **May 21, 2004**, replace "10device" with --device-- before "17". Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

> A person shall be entitled to a patent unless -- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6, 8, 11-13, 16, 20, 24, and 26-33 are rejected under 35 U.S.C. 102(e) as being anticipated by **Carro (U.S. Patent # 6,580,909 B1)**.

Consider **claims 1, 16, 24, and 27-29**, Carro clearly shows and discloses cellular transmission method and a portable communication unit (cellular telephone) 220, 230, 240 (figure 2), comprising:

an antenna (figure 2); and

control logic configured to monitor cellular signals (e.g., registration commands) detected by said antenna (column 4 lines 18-33 and column 6 line 30 - column 7 line 12), a plurality of said cellular signals (e.g., registration commands) transmitted from remote portable communication units (cellular devices) 220, 230, 240 (figure 2) directly to said antenna, said plurality of cellular signals including unique identifiers i of said remote portable communication units (cellular devices) 220, 230, 240 (column 4 lines 18-33, column 5 lines 53-57, column 6 line 30 - column 7 line 12, and claims 1 and 21), said control logic further configured to store said unique identifiers i and to receive a request to transmit to a remote portable communication unit (cellular device) 220, 230, 240 and to make a determination, in response to said request, as to

whether a unique identifier i of said remote portable communication unit (cellular device) 220, 230, 240 is stored in said portable communication unit (cellular telephone) 220, 230, 240 (i.e., transmission is allowed/relayed through the units if the unit requesting/receiving it is registered beforehand (abstract, figure 2, column 5 lines 30-41, column 6 lines 3-26, column 6 line 30 - column 7 line 12, and claims 1-3 and 21-23)), said control logic further configured to transmit a cellular signal based on said determination (column 5 lines 30-41, column 6 lines 3-26, column 6 line 30 - column 7 line 12, and claims 1-3 and 21-23).

Consider **claim 6**, and **as applied to claim 1 above**, Carro further discloses that said control logic is further configured to define said cellular signal such that, if said control logic determines in said determination that said remote unit (cellular device) is identified by one of said signals detected by said antenna, said remote unit (cellular device) is responsive to said cellular signal transmitted by said control logic (abstract, figure 2, column 5 lines 30-41, column 6 lines 3-26, column 6 line 30 - column 7 line 12, and claims 1-3 and 21-23).

Consider **claims 8 and 20**, Carro clearly shows and discloses a cellular transmission method and a portable communication unit (cellular telephone) 220, 230, 240 (figure 2), comprising:

an antenna (figure 2); and

control logic configured to transmit, via said antenna, a cellular signal (e.g., registration command) that identifies a remote unit (cellular device) (column 4 lines 18-33 and column 6 line 30 - column 7 line 12), said control logic further to make a determination as to whether said remote unit (cellular device) is within a transmission range of said portable communication unit

(cellular telephone) 220, 230, 240, said determination made by searching a list of unit (cellular device) identifiers i and locating in said list one of said identifiers i corresponding to said remote unit (cellular device), said control logic further configured to define said cellular signal based on said determination (i.e., when the units are register and their identifiers i are recorded, they are effectively consider to be within transmission range and are allowed to transmit/relay/receive communications (abstract, figure 2, column 4 lines 18-33, column 5 lines 30-41 and 53-57, column 6 lines 3-26, column 6 line 30 - column 7 line 12, and claims 1-3 and 21-23)).

Consider **claims 11 and 23**, and **as applied to claims 8 and 20 above**, Carro further discloses that said control logic is configured to detect whether said unit has received a cellular signal transmitted from said remote unit (cellular device) and to make said determination based on whether said control logic has detected said cellular signal transmitted from said remote unit (cellular device) (column 4 lines 18-33, column 5 lines 53-57, column 6 line 30 - column 7 line 12, and claims 1 and 21).

Consider **claim 12**, and **as applied to claim 8 above**, Carro also discloses that said control logic is configured to transmit said cellular signal directly to said remote unit (cellular device), if said control logic determines in said determination that said remote unit (cellular device) is within said transmission range (column 4 lines 18-33, column 5 lines 53-57, column 6 line 30 - column 7 line 12, and claims 1-3 and 21-23).

Consider **claim 13**, and **as applied to claim 8 above**, Carro further discloses that said remote unit (cellular device), based on said cellular signal, is configured to interface, with a user of said remote cellular device, data included in said cellular signal (e.g., voice communication

through a microphone/speaker) (column 4 lines 18-33, column 5 lines 53-57, column 6 line 30 - column 7 line 12, and claims 1-3 and 21-23).

Consider **claim 26**, and **as applied to claim 1 above**, Carro also shows that said plurality of cellular signals are from a tower 120 (figure 1).

Consider **claim 30**, Carro clearly shows and discloses a portable communication unit (cellular telephone) 220, 230, 240 (figure 2), comprising:

a memory (inherent) (column 4 lines 18-33, where it is disclosed that the identifiers i are recorded);

a microphone (inherent since voice telephone communication is taking place) configured to convert sounds into voice data (column 5 lines 19-23); and

control logic configured to monitor cellular signals (e.g., registration commands) received by said unit (telephone) directly from remote units (cellular telephones) and to store identifiers i from said cellular signals in said memory (column 4 lines 18-33 and column 6 line 30 - column 7 line 12), each of said identifiers i identifying a respective one of said remote units (cellular telephones) (column 5 lines 53-57), said control logic configured to make, in response to a request for establishing a communication session with a particular remote unit (cellular telephone), a determination as to whether said remote unit (cellular telephone) is within a transmission range of said portable communication unit (cellular telephone) 220, 230, 240 based on whether an identifier i is stored in memory (i.e., when the units are register and their identifiers i are recorded, they are effectively consider to be within transmission range and are allowed to transmit/relay/receive communications), said control logic further configured to

transmit, during a communication session, said voice data directly to said particular remote unit (cellular telephone) based on said determination (abstract, figure 2, column 4 lines 18-33, column 5 lines 30-41 and 53-57, column 6 lines 3-26, column 6 line 30 - column 7 line 12, and claims 1-3 and 21-23).

Consider **claim 31**, and **as applied to claim 30 above**, Carro further discloses that said particular remote unit also has a microphone configured to convert sounds into voice data (column 5 lines 19-23) since voice communication is conducted during said session.

Consider **claim 32**, and **as applied to claim 31 above**, Carro further discloses that said unit (telephone) receives said set of voice data from another unit functioning as a relay (column 5 lines 30-41).

Consider **claim 33**, and **as applied to claim 30 above**, Carro further discloses that said control logic is configured to maintain a list of unit (cellular device) identifiers i that are within transmission range and locate in said list one of said identifiers i corresponding to said remote unit (cellular device) in response to said request to make said determination (abstract, figure 2, column 4 lines 18-33, column 5 lines 30-41 and 53-57, column 6 lines 3-26, column 6 line 30 - column 7 line 12, and claims 1-3 and 21-23).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in

section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 2, 9, 19, and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Carro (U.S. Patent # 6,580,909 B1)** in view of **Aarnio (U.S. Patent # 6,522,889 B1)**.

Consider **claims 2 and 9**, and **as applied to claims 1 and 8 above**, Carro clearly discloses the claimed invention except that unit (telephone) further comprises: a lens; and a conversion mechanism configured to convert light received via said lens into digital data, wherein said control logic is configured to include said digital data in said cellular signal transmitted by said control logic.

In the same field of endeavor, Aarnio disclose a cellular device such as mobile station comprising a lens and a conversion mechanism configured to convert light received via said lens into digital data (figure 1 item 13 and column 1 lines 46-51), wherein said control logic is configured to include said digital data in said cellular signal transmitted by said control logic (Wherein the digital data is ultimately conveyed from the cellular device to a communications network, and further analyzed to determine a geographic location (figure 3 steps 3.1-3.8, figure 4

steps 4.1-4.9, column 1 lines 53 and 54, and column 1 line 65 - column 2 line 2)).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the unit taught by Carro to include features such as lens and a conversion mechanism to convert light received into digital data as taught by Aarnio for the purpose of transmitting large amounts of data such as image data without using the resources of a system infrastructure such as bandwidth allocation if a cellular apparatus and a remote device are within a favorable short-range communication distance.

Consider **claims 19 and 22**, and **as applied to claims 16 and 20 above**, Carro clearly shows and discloses the claimed invention except capturing an image via said cellular telephone; defining said image in data; and including said data in said cellular signal transmitted in said transmitting step.

In the same field of endeavor, Aarnio further discloses the steps of: capturing an image via said cellular communication apparatus; defining said image in data (figure 1 and column 1 lines 46-51); and including said data in said cellular signal transmitted in said transmitting step (wherein the digital data is ultimately conveyed from the cellular device to a communications network, and further analyzed to determine a geographic location (figure 3 steps 3.1-3.8, figure 4 steps 4.1-4.9, column 1 lines 53 and 54, and column 1 line 65 - column 2 line 2)).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the method taught by Carro to include the steps taught by Aarnio for the purpose of transmitting large amounts of data such as image data without using the resources of a system infrastructure such as bandwidth allocation if a cellular apparatus and a

remote device are within a favorable short-range communication distance.

9. **Claims 3, 5, 7, 10, 14, 15, 17, 18, and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Carro (U.S. Patent # 6,580,909 B1)** in view of **Grube et al. (U.S. Patent # 5,666,661)**.

Consider **claims 3, 10, 17, and 21**, and **as applied to claims 1, 8, 16, and 21 above**, Carro clearly discloses the claimed invention except that said control logic is configured to transmit a service request signal to a cellular tower.

In the same field of endeavor, Grube et al. disclose a cellular apparatus comprising an antenna (figure 1 items 102 and 103) and control logic configured to monitor cellular signals detected by said antenna (control logic such as means for changing communications modes based on the distance relationship between cellular devices or communication units (column 3 line 56 - column 4 line 9)), wherein said control logic is configured to transmit a service request signal to a cellular tower (wherein the cellular apparatus transmits a communication request to a communication resource such as a cellular tower (column 1 lines 23-29)).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to transmit a service request signal to a cellular tower as taught by Grube et al. in the invention of Carro for the purpose of switching communication modes.

Consider **claims 5, 7, 14, 15, and 18**, and **as applied to claims 1, 8, and 17 above**, Carro clearly discloses the claimed invention except that said control logic is further configured to define said cellular signal such that, if said control logic determines in said determination that

said remote unit (cellular device) is identified by one of said signals detected by said antenna, any cellular tower that receives said cellular signal ignores said cellular signal (claim 5) and that if said control logic determines in said determination that said remote cellular device is not identified by one of said cellular signals detected by said antenna, a cellular tower is responsive to said cellular signal transmitted by said control logic (claim 7).

In the same field of endeavor, Grube et al. disclose a cellular apparatus comprising an antenna (figure 1 items 102 and 103) and control logic configured to monitor cellular signals detected by said antenna (control logic such as means for changing communications modes based on the distance relationship between cellular devices or communication units (column 3 line 56 - column 4 line 9)), wherein said control logic is further configured to define said cellular signal such that, if said control logic determines in said determination that said remote cellular device is identified by one of said signals detected by said antenna, any cellular tower that receives said cellular signal ignores said cellular signal (utilizing identifiers such as the geographic locations of a cellular apparatus and cellular devices to make a determination on whether maintain a current assisted communication mode or change to a direct mode of communications between the cellular apparatus and a cellular device, in which a direct mode of communication implies ignoring the system cellular tower or communication resource (column 3 lines 39-45)), and if said control logic determines in said determination that said remote cellular device is not identified by one of said cellular signals detected by said antenna, a cellular tower is responsive to said cellular signal transmitted by said control logic (the cellular tower or communication resource being responsive by maintaining a system communication resource

mode if not affirmative direct mode operation is met (column 2 lines 15-30 and column 3 line 64 - column 4 line 2).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to ignore or response to said cellular signal at a cellular tower as taught by Grube et al. in the invention of Carro for the purpose of maintaining the communication either directly or through the tower.

10. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Carro (U.S. Patent # 6,580,909 B1)** in view of **well known prior art (MPEP 2144.03)**.

Consider **claim 4**, and **as applied to claim 1 above**, Carro clearly disclose the claimed invention except that said control logic is further configured to include a cellular tower identifier in said cellular signal transmitted by said control logic, if said control logic fails to determine in said determination that said remote unit (cellular device) is identified by one of said signals detected by said antenna.

However, the Examiner takes Official Notice that it is notoriously well known in the art to include a cellular tower identifier (e.g., a base station ID), included on a communication unit once said communication unit is registered in the communication system, in said signal.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include said tower identifier in the signal as well known in the art in the invention of Carro for the purpose of allowing switching of communication modes.

Response to Arguments

11. Applicant's arguments with respect to **claims 1-24 and 26-33** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any response to this Office Action should be **faxed to** (703) 872-9306 **or mailed to**:

Commissioner for Patents
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Hand-delivered responses should be brought to

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13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (571) 272-7915. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Rafael Perez-Gutierrez
R.P.G./rpg RAFAEL PEREZ-GUTIERREZ
PATENT EXAMINER
April 5, 2005